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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/527,785	03/17/2000	Oleg N. Suslov	4350.001200	3947

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EXAMINER

HAYES, ROBERT CLINTON

ART UNIT

PAPER NUMBER

1647

DATE MAILED: 03/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/527,785	Applicant(s) Suslov et al
	Examiner Robert C. Hayes, Ph.D.	Art Unit 1647
		
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --		
Period for Reply		
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>1</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.		
<ul style="list-style-type: none"> - Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). 		
Status		
1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>Dec 28, 2002</u>		
2a) <input type="checkbox"/> This action is FINAL. 2b) <input checked="" type="checkbox"/> This action is non-final.		
3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11; 453 O.G. 213.		
Disposition of Claims		
4) <input checked="" type="checkbox"/> Claim(s) <u>22-53</u> is/are pending in the application.		
4a) Of the above, claim(s) _____ is/are withdrawn from consideration.		
5) <input type="checkbox"/> Claim(s) _____ is/are allowed.		
6) <input type="checkbox"/> Claim(s) _____ is/are rejected.		
7) <input type="checkbox"/> Claim(s) _____ is/are objected to.		
8) <input checked="" type="checkbox"/> Claims <u>22-53</u> are subject to restriction and/or election requirement.		
Application Papers		
9) <input type="checkbox"/> The specification is objected to by the Examiner.		
10) <input type="checkbox"/> The drawing(s) filed on _____ is/are a) <input type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).		
11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action.		
12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.		
Priority under 35 U.S.C. §§ 119 and 120		
13) <input type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).		
a) <input type="checkbox"/> All b) <input type="checkbox"/> Some* c) <input type="checkbox"/> None of: 1. <input type="checkbox"/> Certified copies of the priority documents have been received. 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____. 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).		
*See the attached detailed Office action for a list of the certified copies not received.		
14) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e). a) <input type="checkbox"/> The translation of the foreign language provisional application has been received.		
15) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.		
Attachment(s)		
1) <input type="checkbox"/> Notice of References Cited (PTO-892)		
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)		
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____		
4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____		
5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)		
6) <input type="checkbox"/> Other: _____		

Art Unit: 1647

DETAILED ACTION

Election/Restriction

1. Newly submitted claims 22-53 are directed to inventions that are independent or distinct from the invention originally claimed and examined, in which Applicants originally elected Group II (i.e., a collection of gene transcripts/RNA) in Paper No. 8 without traverse. Therefore, because different considerations and search parameters are used in a complete search of these structurally distinct cDNA libraries, which require different starting materials, different stages of differentiation with different genes being expressed, and because of the non-coextensiveness of the search and examination for each group would constitute an undue burden on the examiner to search and consider each of these separable groups, the following additional restriction requirement of elected Group II is now necessitated.

Note that failure to indicate by page and line number where proper basis exists for the elected invention will be held as being nonresponsive to this Office action, and may result in abandonment of this application.

Note further that it is suggested that improper claim dependencies be corrected (i.e., as it relates to unrelated and distinct inventions).

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
IIi. Claim 22 & 35, drawn to a microclonal cDNA library from a stem cell, classified in Class 435, subclass 320.1.

Art Unit: 1647

Note that claim 35 is directed toward single products, and not a method; and that no "collection" of the following individual cDNA libraries will be considered as being fully responsive to this restriction requirement, unless claims directed to gene transcripts from the complete whole brain at a specific stage of development are independently claimed.

- IIiii. Claim 23 & 35, drawn to a microclonal cDNA library from a neural stem cell, classified in Class 435, subclass 320.1.
- IIii. Claim 23 & 35, drawn to a microclonal cDNA library from a neuronal progenitor cell, classified in Class 435, subclass 320.1.
- IIiv. Claim 23 & 35, drawn to a microclonal cDNA library from a glial progenitor cell, classified in Class 435, subclass 320.1.
- IIv. Claim 24-25 & 35, drawn to a microclonal cDNA library from a glioma tumor cell, classified in Class 435, subclass 320.1.
- IIvi. Claim 26 & 35-36, drawn to a microclonal cDNA library from a hematopoietic cell, classified in Class 435, subclass 320.1.
- IIvii. Claims 27-29 & 32-36, drawn to a microclonal cDNA library from a human early type I neurosphere, classified in Class 435, subclass 320.1.
- IIviii. Claim 30 & 35-36, drawn to a microclonal cDNA library from a late type I neurosphere, classified in Class 435, subclass 320.1.
- IIix. Claim 31 & 35-36, drawn to a microclonal cDNA library from a type II neurosphere, classified in Class 435, subclass 320.1.

Art Unit: 1647

- IIx. Claim 37, drawn to a microclonal cDNA library expressing *B*-actin, classified in Class 435, subclass 320.1.
- IIxi. Claim 37, drawn to microclonal cDNA library expressing *B*-2 microglobulin, classified in Class 435, subclass 320.1.
- IIxii. Claim 37, drawn to microclonal cDNA library expressing neuron-specific enolase, classified in Class 435, subclass 320.1.
- IIxiii. Claims 37, drawn to microclonal cDNA library expressing neurofilament, classified in Class 435, subclass 320.1.
- IIxiv. Claim 37, drawn to microclonal cDNA library expressing MAP-2, classified in Class 435, subclass 320.1.
- IIxv. Claim 37, drawn to microclonal cDNA library expressing PAX-6, classified in Class 435, subclass 320.1.
- IIxvi. Claim 37, drawn to microclonal cDNA library expressing tenascin, classified in Class 435, subclass 320.1.
- IIxvii. Claim 37, drawn to microclonal cDNA library expressing nestin, classified in Class 435, subclass 320.1.
- IIxviii - IIxxxiv. Claims 38, 39, 40, 41, 42, 43, 44, 45, 46, 47, 48, 49, 50, 51 **or** 53, drawn to subtractive cDNA libraries in which each different library is individually restricted (i.e., including those from each of the

Art Unit: 1647

different and distinct disease states listed in claim 53), classified in Class 435, subclass 320.1.

Note that claim 38 is directed toward single products, and not a method; and that no “collection” of the following individual subtractive cDNA libraries or “DNA fragments” will be considered as being fully responsive to this restriction requirement, unless claims directed to specific subtracted gene transcripts from the complete whole brain at specific stages of development are independently claimed.

3. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed. Additionally, in order to be fully responsive to this restriction requirement the claims will need to be amended to a separate cDNA library.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(I).

Art Unit: 1647

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Robert Hayes whose telephone number is (703) 305-3132. The examiner can normally be reached on Monday through Thursday, and alternate Fridays from 8:30 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

RCJ

Robert C. Hayes, Ph.D.
March 24, 2003

Gary J. Kunz
GARY KUNZ
SUPERVISORY PATENT EXAMINER
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